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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,964	07/30/2001	Herbert Martin Wilson	N1205-012	9384

32905 7590 03/11/2004

JONDLE & ASSOCIATES P.C.  
9085 EAST MINERAL CIRCLE  
SUITE 200  
CENTENNIAL, CO 80112

EXAMINER

HELMER, GEORGIA L

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/917,964

### Applicant(s)

WILSON ET AL.

### Examiner

Georgia L. Helmer

### Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1638

### **Office Action**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 11 February 2004 has been entered.

### ***Status of the Claims***

2. Applicant has cancelled claims 1-34, and amended claim 35, 37 and 42 have been amended. Claims 35-43 are pending, and are examined in the instant action.

3. All rejections not addressed below have been withdrawn.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Applicant's substitute specification, accompanied by a marked-up copy of the specification with all amendments to the specification indicated is acknowledged and entered.

### ***Claim Rejections - 35 USC § 112 second paragraph***

6. Claims 38, 42, and 43 are rejected under 35 U.S.C. 112, second paragraph. Claims 38 and 43 remain rejected because of use of the term "gene", for reasons of record.

Claim 42 remains rejected because the "heat shock treatment " conditions are unclear. How is this carried out? Heat shock treatments for bacteria are known in the art, but not for plants. Applicant traverses saying primarily that "heat shock treatment" is well known by one of ordinary skill in the art. Applicant's traversal is unpersuasive because Applicant has given no evidence that this term is well known to one of ordinary skill in the art.

***Claim Rejections - 35 USC § 112-first***

7. Claims 35-42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 35 (a): Applicant has amended "gene" to recite "genetic element". In claim 37 (a) and 42 (a): Applicant has amended "gene" to recite "genetic factor". The recited "genetic factor" is broader than "gene", is new matter. Applicant is invited to point out the page and line number in the specification where "genetic element" and "genetic factor" can be found. Absent such support, Applicant is required to cancel the new matter in response to this Office Action.

Applicant traverses saying primarily that "genetic element" is a well known term by persons of one skilled in the art. Applicant's traversal is unpersuasive because the grounds for this rejection are drawn to whether the term in question, "genetic element", is supported by the specification as originally filed. Applicant has not addressed this issue.

***Claim Rejections - 35 USC § 102***

8. Claims 35, 38, 39, and 40 remain rejected under 35 U.S.C. 102(e) as being anticipated by Hansen, G. (US # 6,162,965) filed June 2, 1997, issued December 19, 2000, for reasons of record, which are repeated in part below.

- Applicant traverses, stating primarily that Hansen, cited by the Examiner, does not disclose or suggest using 19 degree C temperature for co-cultivation with using Agrobacterium 1-2 days after rescue from glycerol stocks, an antibiotic at 15-75 mcg/L and a plant growth medium comprising a monosaccharide. And that therefore, there is not a prima facie case of obviousness.

Applicant's traversal has been considered and is unpersuasive because Applicant's argument is not commensurate in scope with the claims. None of the claims recite the combination of 19 degree C temperature for co-cultivation with using Agrobacterium 1-2 days after rescue from glycerol stocks, an antibiotic at 15-75 mcg/L and a plant growth medium comprising a monosaccharide. Therefore the rejection is maintained.

***Claim Rejections - 35 USC § 103***

9. Claims 35, 36, 37, 38, 39, 40, and 41 remain rejected over Hansen, G. (US # 6,162,965), Bhojwani, SS et al (Developments in Crop Science, vol 5, pp

24-41, 198), Holton (US 5,948,955), and Applicant's admitted prior art, for reasons of record, which are repeated in part below.

- Applicant traverses, stating primarily that the cited references, when viewed separately or in combination, do not teach or suggest the claimed invention.

Applicant's traversal has been considered and is unpersuasive because the combination of references properly renders the claimed invention *prima facie* obvious, for reasons of record. This rejection is maintained because Applicant has provided no evidence to support the allegation.

- Applicant traverses, stating primarily that the Examiner has used an impermissible "obvious to try" standard in reaching the conclusion that Applicant's invention is obvious.

Applicant's traversal has been considered and is unpersuasive because Applicant has provided no evidence that the Office used an "obvious to try" standard.

- Applicant traverses, stating primarily that none of the references cited by Examiner disclose or suggest using 19 degree C temperature for co-cultivation with using *Agrobacterium* 1-2 days after rescue from glycerol stocks, an antibiotic at 15-75 mcg/L and a plant growth medium comprising a monosaccharide. And that therefore, there is not a *prima facie* case of obviousness.

Applicant's traversal has been considered and is unpersuasive because Applicant's argument is not commensurate in scope with the claims. None of the claims recite the combination of 19 degree C temperature for co-cultivation with using Agrobacterium 1-2 days after rescue from glycerol stocks, an antibiotic at 15-75 mcg/L and a plant growth medium comprising a monosaccharide. Therefore the rejection is maintained.

- Applicant traverses, stating primarily that Examiner has randomly picked bits or prior art references using the hindsight reasoning provided by Applicant's disclosure.

Applicant's traversal has been considered and is unpersuasive because Applicant has provided no evidence as to why Applicant believes the Office has used hindsight reasoning.

- Applicant traverses, stating primarily that the Examiner's imputed conclusion of obviousness could only have been reached with the benefit of the hindsight application of the teachings of the present specification.

Applicant's traversal has been considered and is unpersuasive because Applicant has provided no evidence that the Office has used hindsight, as discussed above.

Accordingly, these rejections are maintained.

Art Unit: 1638

**REMARKS**

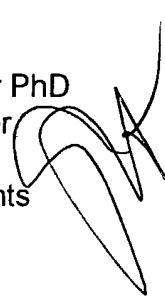
10. No claims are allowed.

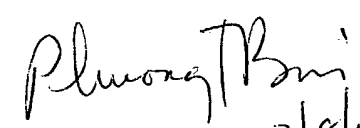
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 571-272-0976. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 571-272-0804. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Georgia Helmer PhD  
Patent Examiner  
Art Unit 1638  
Transgenic Plants  
7 March 2004



  
3/8/04  
PHUONG T. BUI  
PRIMARY EXAMINER